



PATENT

ATTORNEY DOCKET NUMBER: 50125/041002

Certificate of Mailing: Date of Deposit: June 14, 2004

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Colleen Coyne

Printed name of person mailing correspondence

Colleen Coyne

Signature of person mailing correspondence

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Andrea Aschenbrenner et al.	Art Unit:	1624
Serial No.:	10/083,008	Examiner:	K. Habte
Filed:	February 26, 2002	Customer No.:	21559
Title:	COMPOUNDS FOR THE TREATMENT OF PROTOZOAL DISEASES		

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REPLY TO NOTICE OF ALLOWANCE

In reply to the Notice of Allowance that was mailed in connection with the above-captioned case on April 28, 2004 and having confirmation number 4309, enclosed are:

A completed fee transmittal form PTOL-85; and

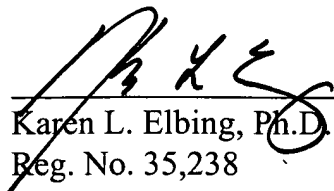
A check for \$995.00 to cover the issue fee required by 37 C.F.R. § 1.18(a) of \$665.00, the publication fee of \$300.00, and the patent copy fee required by 37 C.F.R. § 1.19(a)(1)(i) of \$30.00 for ten patent copies.

If there are any other charges or any credits, please apply them to Deposit Account

No. 03-2095.

Respectfully submitted,

Date: 14 June 2004

  
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Serial No.: 10/083,008 Examiner: K. Habte  
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705

In response to the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) mailed with the Notice of Allowance on April 28, 2004 in connection with the above-captioned patent application, Applicants hereby request reconsideration of the patent term adjustment. Applicants submit that the current patent term adjustment should be 57 days, i.e., the period of 61 days representing the excess of fourteen months from the filing date of the present patent application to the mailing date of the Requirement for Restriction, reduced by 4 days representing the period greater than the three-month

statutory period for reply to the non-final Office Action of October 16, 2003.

In support of this application, Applicants first summarize crucial dates and actions that result in patent term adjustment. The present patent application was filed on February 26, 2002. A Notice to File Missing Parts was mailed on April 4, 2002, to which Applicants responded June 4, 2002. This submission was received by the U.S. Patent Office on June 12, 2002, as indicated by the accompanying PAIR print-out (Exhibit A). The first Office Action under 35 U.S.C. § 132 was mailed June 26, 2003, to which Applicants responded September 23, 2003 (received by the PTO September 25, 2003). A non-final Office Action was mailed October 16, 2003, to which Applicants responded January 16, 2004 (received by the PTO January 20, 2004).

The rules governing patent term adjustment due to examination delay are provided for in 37 C.F.R. § 1.702, which states:

[T]he term of an original patent shall be adjusted if issuance of the patent was delayed due to the failure of the Office to:

- (1) Mail at least one notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a).

37 C.F.R. § 1.703 states:

(a) The period of adjustment under 1.702(a) is the sum of the following periods:

- (1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) ... and ending on the mailing date of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

With regard to reductions in patent term adjustment, 37 C.F.R. § 1.704(b) states:

[T]he period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning the day after the date that is three months after the mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

In addition, 37 C.F.R. § 1.703(f) states that the “date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account” in calculating the period of patent term adjustment.

The period from the February 26, 2002 filing date of the present application to the June 26, 2003 mailing date of the Requirement for Restriction spans fourteen months and 61 days. The only delay on Applicants’ part during the prosecution of the present case is the mailing delay of 4 days associated with the filing of Applicants’ Reply to the Office Action of October 16, 2003. Applicants submit therefore that the patent term should be extended for 57 days, the 61-day period in excess of the fourteen-month time period provided for in 37 C.F.R. § 1.702 reduced by the 4-day Applicant mailing delay. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination as set forth in 37 C.F.R. § 1.704.

Applicants’ calculation of the patent term adjustment period differs from that calculated by the Office, and Applicants submit that the Office’s calculation is in error. Applicants note that the PAIR system indicates an additional Applicant delay of 21 days. This time period occurred between the PTO’s receipt of Applicants’ submissions in

response to the Notice to File Missing Parts (June 12, 2002) and a PAIR entry indicating that the “Application is Now Complete” (July 25, 2002). The 21-day delay in question presumably reflects the time period between the end of the three-month statutory period for reply to the Notice to File Missing Parts (July 4, 2002) and the Complete Application PAIR entry (July 25, 2002). It is inappropriate, however, to reduce Applicants’ patent term adjustment by these 21 days as Applicants’ submission was timely filed on June 12, 2002, and the time period from June 12<sup>th</sup> to July 25<sup>th</sup> reflects Patent Office processing and is therefore the result of PTO, and not Applicant, delay. It is clear that the PTO received Applicants’ submission on June 12, 2002 – that is, within three months of the mailing date of the Notice to File Missing Parts. Accordingly, the submission was timely filed under 37 C.F.R. § 1.704(b), and the period of patent term adjustment should not be reduced on this basis.

In addition, Applicants note that the present patent application is not subject to a Terminal Disclaimer.

In view of the above facts, this application is currently entitled to 57 days of patent term adjustment under 37 C.F.R. § 1.703.

CONCLUSION

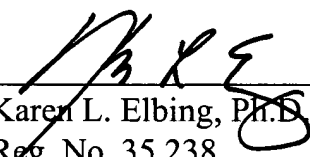
Applicants submit that the current patent term adjustment should be 57 days and request reconsideration of the patent term adjustment.

Enclosed is a check in the amount of \$400.00 for the fee set forth in 37 C.F.R.

§ 1.18(f). If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 14 June 2004

  
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